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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,344	04/12/2001	Rabindranath Dutta	AUS920010211US1	3787
35525	7590	01/06/2006	EXAMINER	
IBM CORP (YA)			KYLE, CHARLES R	
C/O YEE & ASSOCIATES PC				
P.O. BOX 802333			ART UNIT	
DALLAS, TX 75380			PAPER NUMBER	
			3624	

DATE MAILED: 01/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/833,344

Applicant(s)

DUTTA ET AL.

Examiner

Charles Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 15, 16, 18-24, 32, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 15, 16, 18-24, 32, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date October 24, 2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7, 15, 16, 18-24, 32 and 34-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. They contain the phrase “wherein the markup language representation of the check includes a signed document markup language”. The Examiner considers that it is unlikely that Applicant intends that the representation of a check contains an entire markup language, which would contain non-terminal symbols, terminal symbols, production rules and an unambiguous grammar. The Claims are examined with an assumption that the intended phrasing is akin to “wherein the markup language representation of the check includes a signed document markup language representation of a check element.”

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-7, 15, 16, 18-24 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,786,398 *Stinson et al* in view of *SDML - Signed Document Markup Language W3C Note*, hereinafter, *Note*.

As to Claim 1, *Stinson* discloses the invention substantially as claimed, including in a method in a data processing system for processing a check in an automatic teller machine (Fig. 6A; Col. 5, lines 23-26), steps of:

receiving a check in the automatic teller machine (Col. 7, lines 46-48);

scanning the check within the automatic teller machine to generate an image (Col. 7, lines 48-53);

performing optical character recognition on the image to generate data; and

creating a electronic representation of the data (Col. 9, lines 49-62).

Stinson does not specifically disclose that the check data is used to produce a markup language representation of the check, wherein the markup language representation of the check includes a signed document markup language representation of a check element. *Note* discloses this limitation at pages 3-5, particularly the bracketed text. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Stinson* to include the markup language representation of the check includes a signed document markup language representation of a check element disclosed by *Note* because this would provide the security benefits specifically set out by *Note* at pages 3-5, starred text.

Regarding Claim 2, *Stinson* discloses scanning both sides of a check at Col. 7, lines 48-63.

Regarding Claim 3, *Note* discloses that the markup language is a financial services markup language pages 3-4.

Concerning Claim 4, *Note* discloses transmission of an electronic representation of a check at page 4, “checked” text and that the electronic representation is in markup language at pages 3-5.

With respect to Claim 5, *Stinson* discloses the institution as a banking institution at Summary of the Invention.

Concerning Claim 6, *Stinson* discloses sending images of the check at Col. 7, line 66 to Col. 8, line 11.

Concerning Claim 7, *Stinson* discloses reading micr ink at Col. 7, line 48-53.

As to Claim 15, *Stinson* discloses the invention substantially as claimed including in an automatic teller machine (Col. 5, lines 23-26; Fig. 6A):

a check processing unit, wherein the check processing unit receive: and manipulates checks received by the automatic teller machine (Fig. 3, ele. 130, Col. 25-36);

a cash money dispenser, wherein the cash money dispenser is operable to disperse currency in response to a selected signal (Fig. 3, ele. 135; Col. 5, lines 23-26);

a scanner unit, wherein the scanner unit is operable to scan checks (Fig. 3, ele. 315, Col. 7, lines 48-53);

a memory, wherein the memory includes a set of instructions (Fig. 3, ele. 325; Col. 5, line 63+); and

a processor unit(Fig. 3, ele. 300), wherein the processor unit executes the set of instructions to initiate scanning of the check by the scanning unit to generate an image of the check and perform optical recognition on the image of the check for generate data (Col. 9, lines 48-63.

Stinson does not specifically disclose that the check data is used to create a markup language representation of the check. *Note* discloses this limitation at pages 3-5, particularly the bracketed text It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Stinson* to include the markup language representation of the check includes a signed document markup language representation of a check element disclosed by *Note* because this would provide the security benefits specifically set out by *Note* at pages 3-5, starred text.

As to Claim 16, *Stinson* discloses a user response processed by instructions at Col. 17, lien 13 to Co. 18, line 14. See also Col. 14, lines 27-38.

Concerning Claims 18-24, see the discussion of Claims 1-7, respectively. See also Figs. 1-6B.

Concerning Claim 32, see the discussion of Claim 1 and Col. 14, lines 27-38.

Claims 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,786,398 *Stinson et al* in view of *SDML - Signed Document Markup Language W3C Note*, hereinafter, *Note* and further in view of US 6,654,797 *Kamper*.

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As to Claims 34-35, *Stinson* discloses the invention substantially as claimed. See the discussion of Claims 1 and 20 respectively. *Stinson* does not specifically disclose that a verification smart card self-destructs after a predetermined number of input attempts. *Kamper* discloses this limitation at Col. 5, lines 36-45. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Stinson* to include the self destruct feature of *Kamper* because this would enhance security by preventing operation by a person who was clearly not in possession of valid verification data.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kyle whose telephone number is (571) 272-6746. The examiner can normally be reached on 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

crk
January 4, 2006

Primary Examiner
Charles Kyle
Art Unit 3624

